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10/083,376

02/27/2002

Daisuke Miyakoshi

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04/06/2005

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EXAMINER

TO, TUAN C

ART UNIT

PAPER NUMBER

3663

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/083,376

Applicant(s)

MIYAKOSHI ET AL.

Examiner

Tuan C To

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/03/2003, 04/07/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-6, 9-17, and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Bates et al. (US 20010055974A1).

With respect to claims 1 and 9, the U.S reference No. '974A1 to Bates et al. has been cited as teaching a system and method for selectively ringing one or more lane phones or portable phones based on the geographic position of a portable phone. A portable phone (100) (Bates et al, figure 1), which is the claimed portable information terminal, shows that the position detector (220) is the claimed receive unit, provided for determining the geographic position of the portable phone; the memory (230), which is the claimed storage unit, is the combination of volatile memory and non-volatile memory for storing location information (geographic region) and parameters to go along with each geographic location. Bates et al. disclose "the data being correlated with last

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location information received by the receive unit, and when received location information is different from last received location information, extracting data on the current received location information from among data stored in the storage unit". It is truth because, the mentioned storage unit (230) stores the location data and correlates the data with the received location information received from the unit (220) (Bates et al, page 3, paragraph 0036). When a user who carrying the portable phone to a new location that is different from the location information, the data belongs to that location would be retrieved. Bates et al. also disclose a display (130) for notifying a user of the information the data that belongs to a geographic location that has been stored in the portable phone . Thus, Bates et al. additionally discloses the limitation: "an information notification unit to notify a user of the portable information terminal of information corresponding to the extracted data. In addition, the microphone (150) is considered as the data obtaining device as claimed in the present invention.

With regard to claim 2, the reference to Bates et al. as discussed above, discloses that the storage unit (230) stores and correlates data and location information received by the unit (220). In figure 2 of Bates et al., there is included a keypad (120) is ready for user to instruct the data stored in the storage unit (230).

With regard to claim 3, the keypad (120) represented above herein includes a variety of keys for user to select either a location information or data from different pre-stored location information, and data stored in the memory (230) (page 2, paragraphs 0032, 0034).

With respect to claim 4, the position detector (220) as represented herein is the claimed receive unit for receiving location information; the memory (230) is the claimed storage unit. A user uses one of the keys of key pad (120) to instruct the storage unit to store data. The storage unit (230) correlates and stores the data (telephone parameters) and location information received by the position detector unit (220).

With respect to claim 5, the keypad (120) represented above herein includes a variety of keys for user to select either a location information or data from different pre-stored location information, and data stored in the memory (230) (page 2, paragraphs 0032, 0034). The storage unit (230), as illustrated in Bates et al, stores and correlates the data and the geographic region select by the user (Bates et al, page 3, paragraphs 0035, 0036).

With regard to claim 6, figure 1 of Bates et al. shows that the notification unit includes the display (130), and speaker (140). Therefore, the teachings of Bates et al. read on the limitation "wherein the information notification unit is a liquid crystal display for displaying an image corresponding to the data, or is a speaker for outputting sound corresponding to the data.

With regard to claims 10-12, the position detector (220) is illustrated in Bates et al. as a GPS receiver, and that the location information is obtained based on a signal received by said the position detector (220) (Figure 1; page 3, paragraphs 0036, 0037).

With respect to claim 13, the memory (230) represented herein for correlating and storing data and location information. The position detector (220) is provided for receiving location information. The data correlated with the received information from

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among the data stored at the storing step can be extracted and notify a user by such the data.

With respect to claim 14, the position detector(220) as represented herein is the claimed receive unit for receiving location information; the memory (230) is the claimed storage unit. A user uses one of the keys of key pad (120) to instruct the storage unit to store data. The storage unit (230) correlates and stores the data (telephone parameters) and location information received by the position detector unit (220).

With respect to claim 15, the keypad (120) represented above herein includes a variety of keys for user to select either a location information or data from different pre-stored location information, and data stored in the memory (230) (page 2, paragraphs 0032, 0034).

With respect to claim 16, the memory (230) represented herein for correlating and storing data and location information. The position detector (220) is provided for receiving location information. The data correlated with the received information from among the data stored at the storing step can be extracted and notify a user by such the data.

With respect to claim 17, the position detector (220) as represented herein is the claimed receive unit for receiving location information; the memory (230) is the claimed storage unit. A user uses one of the keys of key pad (120) to instruct the storage unit to store data. The storage unit (230) correlates and stores the data (telephone parameters) and location information received by the position detector unit (220).

With regard to claim 22, the microphone (150) disclosed in Bates et al. is considered as the data obtaining device as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 8, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (US 20010055974A1) and in view of Stewart (US 6049718A).

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With respect to claims 7 and 8, Bates et al. explicitly disclose the limitations of claims 1 and 4 except for that "the location information is a base station code of a base station with which the portable information terminal is communicating".

The US reference to Stewart, as represented herein, discloses a portable telephone comprising: a storage (50) for storing location code, which is the base station code of a base station as claimed in the present invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Bates et al. to include the teachings as taught by Stewart so that the location data of a base station is generated correspondingly from the base station code which station is communicating to a portable telephone.

With respect to claims 18-21, Bates et al. teach that the portable phone includes a computer system that has been associated with a storage medium (230), but Bates et al. do not disclose that said storage medium storing a program for enabling a computer to carry out the steps as represented in claims 18-21.

Stewart teaches a telephone system, from which the portable telephone (28) (Stewart, figure 2, column 5, lines 41-62) includes the processor (32) that associated with a main storage (48), and said processor is programmed to execute the methods performed by the telephone.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Bates et al. and Stewart in order to



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provide the convenient to user every time, anywhere, when the user carry such the phone to work, on the way home, etc

### **Conclusions**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (703) 308-6273.

The examiner can normally be reached on from 8:00AM to 5:00PM.

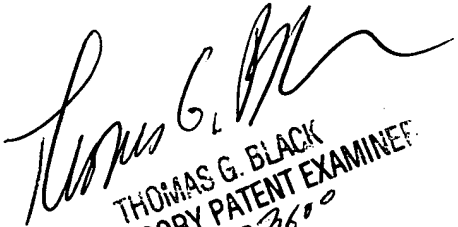
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on (703) 305-8233.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/tc

March 24, 2005

  
THOMAS G. BLACK  
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GROUP 3610